



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/654,663

09/03/2003

Corinne Bortolin

16222U-015900US

5371

20350

7590

01/24/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

ST CYR, DANIEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,663

Applicant(s)

BORTOLIN ET AL.

Examiner

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-29 and 47-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-29 and 53-58 is/are allowed.
- 6) ☒ Claim(s) 47-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This in response to the applicant' amendment filed 11/14/05

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 47-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shepley, US Patent No. 6,024,281, in view of Drupsteen, US Patent No. 6,073,238.

Shepley discloses a nutritional information system comprising: retrieving a first data string from a portable consumer device 52 comprising a computer readable medium comprising the first data string, using a card access device 51, wherein the first data string is associated with a consumer; and comparing the first data string to a second data string (food info) using the card access device or a server in communication with the card access device, wherein the second data

Art Unit: 2876

string comprises an identification code for a product that is purchased by the consumer (see col. 7, line 1-40).

Re claim 48, the system is capable of changing the food preference depending on the consumer health condition and desire. (see col. 5, lines 45-48)

Re claim 49, wherein the portable consumer device is in the form of a card 52.

Re claim 52, wherein the identification code is a universal product code (bar code) (col. 6, line 22).

Shepley fails to disclose or fairly suggests that the first data string includes at least a wildcard value.

Drupsteen discloses a method of securely loading commands in a smart card comprising: a body 2; and a computer readable medium 12 coupled to the body, the computer readable medium comprising a data string MC1, MC2, MC3, MC4 including one or more wildcard values, wherein the data string is specifically associated with the consumer; and a card reader serving as an access device. (see figures 1-3, and col. 3, line 34 to col. 5, line 16).

In view of Drupsteen' teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Shepley to include wildcard values in the data string associated with the user. Such modification would make the user data structure more compact (i.e. being able to provide additional information), which would make the system more effective, wherein the additional could be more descriptive in setting the user' preference. And the wildcard value would provide automatically filtering query of data comparing. For instance a wildcard value could be associated with foods having specific

Art Unit: 2876

ingredients, such as cholesterol, sodium content etc., wherein such wildcard value would filter or query all foods having these characteristics. Therefore, it would have been an obvious extension as taught by Shepley.

Re claims 50 and 51, Shepley as modified by Drupsteen fails to disclose a customized reward. However, it is customary to provide promotional products through a customized reward program. For instance, when a customer purchases a certain product, the customer receives another product free or receives a discount coupon for a similar or a different product.

It would have been obvious for an artisan to incorporate a reward program into the system of Shepley as modified by Drupsteen for providing promotional product. Such modification would make the system more desirable, wherein more customers would patronize the business, which would make it more profitable. Therefore, it would have been obvious to an ordinary artisan to implement such reward program into the system of Shepley as modified by Drupsteen.

Allowable Subject Matter

5. Claims 20-29 and 53-58 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter:

Although the prior art of record teaches a system for establishing customers' food preferences so to assist customers on food shopping, setting up a reward program through a merchant database for rewarding a customer when some specific items are selected to be purchased, etc., the prior art of record fails to disclose that the customers' preference data having wildcard values is stored in a portable medium (i.e. a portable card), wherein when a product is selected to be purchased, it is compared with the preference data in the portable medium, if the preference data encompasses

Art Unit: 2876

the selected product a reward is given to the customer or informing the customer that he is entitled to a reward. These limitations in conjunction with other limitations in the claims were not shown by, would not have been obvious over, nor would have been fairly suggested by the prior art of record.

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

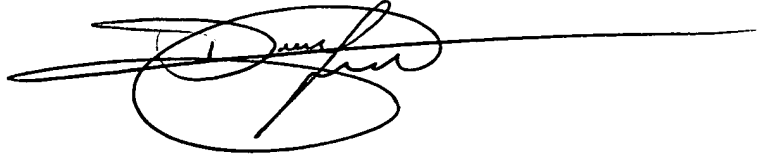
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr
Primary Examiner
Art Unit 2876

A handwritten signature in black ink, appearing to read 'Daniel St. Cyr', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.

DS
January 20, 2006